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Docket No.: SON-1582
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Masumitsu Ino et al.

Application No.: 09/424,544

Confirmation No.: 8128

Filed: November 24, 1999

Art Unit: 2629

For: LIQUID CRYSTAL DISPLAY

Examiner: J. J. Piziali

REQUEST FOR REHEARING

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Receipt is acknowledged of the Decision on Appeal ("the Decision") mailed September 7, 2011 from the Board of Patent Appeals and Interferences ("the Board").

This is a Request for Rehearing under 37 C.F.R. §41.52 in response to the Decision.

This Request is limited to points and authorities believed to have been misapprehended or overlooked by the Board in rendering its Decision. 37 C.F.R. §41.52.

Remarks/Arguments begin on page 2 of this paper.

REMARKS

i. Arguments.

Claims 25-29, 31, 37, and 43-78 are rejected within the Final Office Action of May 28, 2008 ("the Final Office Action").

A. It is respectfully submitted that the indication of "*Affirmed*" on page 9 of the Decision is believed to have been misapprehended or overlooked by the Board.

U.S. Patent and Trademark Office practice and procedures pursuant to 37 C.F.R. §41.50(a)(1) provide the following:

The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

The Manual of Patent Examining Procedure (M.P.E.P.), Eighth Edition, August 2001, Latest Revision July 2010, provides the following in section 1213:

After consideration of the record including appellant's >briefs< and the examiner's >answers<, the Board writes its decision, affirming the examiner in whole or in part, or reversing the examiner's decision, sometimes also setting forth a new ground of rejection. M.P.E.P. §1213.

Here, the Decision *did not sustain each and every rejection* made within the Final Office Action.

Specifically, the Final Office Action includes a rejection of claims 25-29, 31, 37, 43-48, and 67-78 under 35 U.S.C. §112, second paragraph.

The Decision on page 6 *did not sustain* this rejection under 35 U.S.C. §112.

Nonetheless, page 9 of the Decision has apparently indicated an *affirmance-in-whole*.

In this regard, it is believed that the *affirmance-in-whole* indicated on page 9 of the Decision appears to have *failed to take into consideration* the rejection under 35 U.S.C. §112, second paragraph, *not being sustained* (Decision, page 6).

As a result of the rejection under 35 U.S.C. §112 not being sustained, it is respectfully submitted that the Decision should have indicated an “*affirmance-in-part*”, at the very most, instead of the *affirmance-in-whole*.

➤ *Thus, the indication on page 9 of the Decision of what appears to be an affirmance-in-whole instead of an “affirmance-in-part”, at the very most, is believed to have been misapprehended or overlooked by the Board.*

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B. It is respectfully submitted that all arguments presented in the Appeal Brief and Reply Brief to claim 48 are believed to have been misapprehended or overlooked by the Board in rendering its Decision.

U.S. Patent and Trademark Office practice and procedures pursuant to 37 C.F.R. §41.37(c)(1)(viii) include the following:

- Each ground of rejection must be treated under a separate heading.
- For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group.
- Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

Page 6 of the Decision provides the following:

Appellants argue claims 25-29, 31, 37, 43-48, and 71-78 as one group for their rejections as anticipated by Takeda or Hirai and as obvious over Takeda and Hirai (App. Br. 19-27) and state that these claims stand or fall together (App. Br. 19). Therefore, we select claim 25 as representative of this group of claims.

In response, the Final Office Action includes rejections of claims 25-29, 31, 37, and 43-78 under 35 U.S.C. §102 and 35 U.S.C. §103.

The Appeal Brief of December 2, 2008 (“the Appeal Brief”) appeals the final rejection of claims 25-29, 31, 37, and 43-78.

Specifically, page 19 of the Appeal Brief indicates a grouping that includes claims 25-29, 31, 37, 43-47, 71-78 as standing or falling together.

Here, claim 48 is expressly excluded from this grouping.

Instead, page 5 of the Appeal Brief provides a concise explanation of the subject matter defined in claim 48. 37 C.F.R. §41.37(c)(1)(v).

Page 27 of the Appeal Brief has indicates another separate grouping that includes claim 48 standing or falling alone. 37 C.F.R. §41.37(c)(1)(vii).

On this point, arguments pertaining to the use of U.S. Patent No. 4,825,203 (Takeda) and U.S. Patent No. 5,440,304 (Hirai), which the Examiner had relied upon in rejecting dependent claim 48, are before the Board.

For example, page 27 of the Appeal Brief argues the following:

***Claim 48 stands or falls alone** - Claim 48 is dependent upon claim 25. Claim 48 includes the features of a display according to claim 25, wherein said plurality of driver circuits are driver integrated circuits arranged in an outside of a transparent insulating substrate on which said display portion is formed.*

However, Takeda and Hirai, either individually or as a whole, fail to disclose, teach or suggest the presence of a transparent insulating substrate.

As noted within the Appeal Brief, claim 48 is dependent upon claim 25. The subordinate claims by their nature require fewer words of explanation on appeal. *In re Beaver*, 13 USPQ2d 1409, 1410 (Fed. Cir. 1989)(*Decision of the Board vacated and remanded with instructions to redetermine the issues as to all claims on appeal*).

The arguments relating to claim 48 as presented on page 27 of the Appeal Brief were apparently not deemed inadequate by the Examiner. *In re Beaver* at 1410-11.

In particular, the Examiner's Answer of April 14, 2009 ("the Examiner's Answer") responded to the arguments for claim 48 that were presented within the Appeal Brief. *In re Nielson*,

2 USPQ2d 1525, 1527 (Fed. Cir. 1987)(**Board erred** in stating that appellant failed to argue the dependent claims separately).

Case in point, the Examiner's Answer beginning on page 52 attempts to cite the columns and line numbers in Takeda and Hirai in an attempt to locate within the references where the disputed elements of claim 48 could be found. *In re Lovin*, 99 USPQ2d 1373, 1375 (Fed. Cir. 2011).

In responding to the Examiner's Answer, the filing of the Reply Brief of August 27, 2009 ("the Reply Brief") is as a matter of right. M.P.E.P. §1208. This procedure is appropriate under U.S. Patent and Trademark Office practice and procedures. *In re Nielson* at 1527. See also 37 C.F.R. §41.41. The Reply Brief **does not merely repeat the arguments** presented within the Appeal Brief. Instead, pages 3-13 of the Reply Brief address the specific assertions raised by the Examiner's Answer.

The Federal Circuit instructs that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for appellate review. *Gechter v. Davidson*, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997)(*Decision of the Board vacated and remanded for specific findings of fact and conclusions of law adequate to form a basis for appellate review*).

In accordance with this instruction, the Board **must** consider the patentability of any grouped claim separately. 37 C.F.R. §41.37(c)(1)(viii). By rule, separate consideration of claim 48 by the Board in its Decision is **non-discretionary**.

Here, the Appeal Brief and the Reply Brief reasonably argued claim 48. There was no forfeiture of the right to appeal the rejection of claim 48 that was argued before the Board. *In re Nielson* at 1527.

Nonetheless, the Decision has **failed to consider the any argument** presented within the Appeal Brief and the Reply Brief **that specifically pertained solely to claim 48**, notwithstanding claim 48 being separately argued within both the Appeal Brief and the Reply Brief.

On this point, the selection of claim 25 in the Decision as the lone representative claim for the rejection of claims 25-29, 31, 37, 43-48, and 71-78 under 35 U.S.C. §102 and 35 U.S.C. §103 while also ignoring separate arguments to claim 48 made within the Appeal Brief and the Reply Brief is not in accordance with established practice and procedures pursuant to 37 C.F.R. §41.37(c)(1)(viii).

It is not only unfair to the applicant, it is also inefficient to decline to review claims that are properly appealed and reasonably argued before the Board. *In re Beaver*, 13 USPQ2d 1409, 1411 (Fed. Cir. 1989)(*Decision of the Board vacated and remanded with instructions to redetermine the issues as to all claims on appeal*).

➤ *As a consequence, the presence of separate arguments pertaining to dependent claim 48 in both the Appeal Brief and the Reply Brief along with the absence by the Board of any consideration of those arguments pertaining to specifically claim 48 is believed to have been misapprehended or overlooked by the Board in rendering its Decision.*

* * *

ii. Conclusion.

The previously stated points are believed to have been misapprehended or overlooked in the Decision and are grounds upon which rehearing is sought.

Accordingly, the Board is respectfully requested to reconsider its Decision in this matter.

Favorable reconsideration of the claims on appeal in light of the remarks is courteously solicited.

Dated: October 19, 2011

Respectfully submitted,

By 

Christopher M. Tobin

Registration No.: 40,290

RADER, FISHMAN & GRAUER PLLC

Correspondence Customer Number: 23353

Attorney for Applicant